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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,305	07/11/2003	Heribert Reich	REICH5	3597

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/617,305	Applicant(s) REICH ET AL.	
	Examiner Marc Jimenez	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07112003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of Group I, Claims 1-8 in the reply filed on 5/10/05 is acknowledged. The traversal is on the ground(s) that claim 9 has been amended to specify that the flutings are "ground". This is not found persuasive because the product could be made by using a materially different process. The product as claimed could be made by using a blade cutting tool such as that shown in Hoagland (US 1,704,192) instead of a grinding device. Furthermore, the product could be made by casting to form the flutings. Note that the patentability of product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citing *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969)). If a product in a product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product is made by a different process. *Id.* citing *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F. Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Applicant argues that a complete search and examination of the Group I claims would require a search and consideration of Group II, and therefore there would be no serious burden in searching and examining both groups. However, when conducting a search for product claims, the way the product is made is irrelevant to the patentability of the product. It is the structural features of the product that must be found in determining patentability of the product. Therefore, a serious burden exists in searching for both the product and process claims.

The requirement is still deemed proper and is therefore made FINAL.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the European Patent Office on 7/11/02. It is noted, however, that applicant has not filed a certified copy of the EPO 02 015 396.1 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 4, 7, and 8** rejected under 35 U.S.C. 102(b) as being anticipated by Hyde (US 5,582,874).

Hyde teaches that it was well known in the art to provide a fluted roll-blank with a central longitudinal axis and with a longitudinal direction that is parallel thereto and with a surface, providing a grinding device for grinding (col. 3, lines 29-30), on the surface, flutings (col. 3, line 31) that run in the longitudinal direction, the flutings comprising fluting heads and roots that are parallel to each other and are regularly and alternately distributed along the circumference of the surface, and grinding fluting heads on the surface by means of the grinding device (col. 3, lines

Art Unit: 3726

29-30 and lines 32-34), the fluting heads having the same cross-sectional curvature in the longitudinal direction.

Regarding claim 4, note that a grinding wheel is used (col. 3, lines 29-30).

Regarding claim 7, the grinding wheel (col. 3, lines 29-30) is set to the surface of the fluted-roll blank (col. 3, lines 32-34).

Regarding claim 8, the grinding device is considered to grind "a part of the two roots that adjoin the heads" because the grinding device would be used to grind the entire outer surface of the roll.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 2 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde in view of either one of Sukenik (US 4,531,996) or Osgood (US 3,919,029).

Hyde teaches the invention cited with the exception of having a diameter that varies in the longitudinal direction or having a "swell".

Sukenik teaches corrugating rolls that are crown shaped (col. 1, lines 29-30) which is considered to have a swell and a diameter that varies.

Art Unit: 3726

Osgood also teaches corrugating rolls that have a crown shape (figure 4) which is considered to have a swell and a diameter that varies.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Hyde with a diameter that varies in the longitudinal direction or having a “swell”, in light of the teachings of either one of Sukenik or Osgood, in order to provide a more even corrugating force as suggested by Sukenik at col. 1, lines 26-28).

7. **Claims 5 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde in view of Junker (US 4,548,000).

Hyde teaches the invention cited with the exception of the grinding wheel having two radially projecting annular beads and an annular recess that is disposed there-between and stands back radially.

Junker teaches a grinding wheel I having two radially projecting annular beads 6,7 and an annular recess that is disposed there-between and stands back radially.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Hyde with the grinding wheel having two radially projecting annular beads and an annular recess that is disposed there-between and stands back radially, in light of the teachings of Junker, in order to grind multiple flutes at the same time.

Art Unit: 3726


Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number (571) 272-4530. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ
July 8, 2005


MARC JIMENEZ
PRIMARY EXAMINER
7/8/05